

Amendment and Response

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Joyce B. PALAZZOTTO et al.

Serial No.: 10/067,141

Confirm't'n No.: 7314

Filed: 04 February 2002

For: SPEECH TRANSMISSION ADAPTOR FOR USE WITH A RESPIRATOR
MASK

Remarks

The Office Action dated 21 March 2002 has been received and reviewed. Claim 12 having been amended, the pending claims are claims 1-20. Reconsideration and withdrawal of the rejections are respectfully requested

The 35 U.S.C. §112, First Paragraph, Rejection

Claims 1-20 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action asserts that the language "spacer," "strain relief means," "said spacer having a microphone extending therefrom," and "a microphone extending therefrom and into an interior of said face mask" is not supported by the specification as originally filed. Applicants traverse this rejection.

With respect to the rejection generally, Applicants note that the Office Action does not provide any "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed." MPEP § 2163 (III)(A), p. 2100-166 (Aug. 2001). For that reason alone this rejection does not satisfy the requirements for a *prima facie* case of failure to provide an adequate written description in compliance with § 112, first paragraph.

With respect to the phrase "a microphone extending therefrom and into an interior of said face mask," Applicants note that the particular phrase "an interior of said face mask" does not appear in the claims.

Furthermore, the Office action fails to note that the term "spacer" is explicitly recited in this continuation application at, e.g., page 4, lines 21-23; page 9, lines 10-13; and page 9, lines 23-25.

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In view of Applicants' attempt to provoke an interference between the present application and U.S. Patent No. 5,463,693 to Birli et al. based on the original application U.S. Serial No. 08/130,299 filed on October 1, 1993 (the earliest effective filing date of the present application), Applicants will address support for the pending claims in the original application.

Although Applicants recognize that the claim terms/phrases identified in this Office Action may not have been explicitly recited in the original application, Applicants submit that the pending claims are fully supported by that application in compliance with the requirements of 35 U.S.C. § 112, first paragraph.

As support for use of the term "spacer," Applicants direct the Examiner's attention to Figures 4-6 of the original application, where the spacer/speech transmission adapter 50 is depicted in the various views as providing a space between the filter 46 and the inhalation port 38. That spacer/speech transmission adapter 50 provides the space used to "expand the clean air envelope" as described in the specification of the original application at, e.g., page 12, line 15 to page 13, line 14, thereby providing a space for a microphone.

As support for the phrase "strain relief means," Applicants direct the Examiner's attention to Figures 3 & 4 which clearly depict coils in the wire 76. Applicants submit that coiled wires can provide one form of strain relief from forces encountered by attachment of the wire 76 to the spacer/speech transmission adapter 50.

As support for the phrase "said spacer having a microphone extending therefrom," Applicants would direct the Examiner's attention to Figures 4-6 of the original application which depict a microphone 74 extending from the peripheral housing 70 of the spacer/speech transmission adapter 50. Further reference can be made to, e.g., page 15, lines 8-15 and original claims 1, 5, 7, 11, 13, 17, 18, and 20.

To require explicit recitation of the terms recited in the Office Action as the basis for this rejection misconstrues the requirements of the first paragraph of § 112. "The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for

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the disclosure to satisfy the description requirement." MPEP § 2163.02 (August 2001). Rather, "Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive words, structures, figures, diagrams and formulas that fully set forth the claimed invention." MPEP § 2163.02 (August 2001) (citing *Lockwood v. American Airlines, Inc.*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)).

Applicants submit that support can be found for the language objected to in the Office Action in the original application as discussed above. That support can be found in the text as well as in the figures. Appendix B (discussed with respect to the interference issues below) also provides guidance regarding support for the claims. For the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under § 112, first paragraph.

Interference

As noted in the Communication filed with the present continuation application, claims 1-20 are presented for the purpose of provoking an interference between the present application and U.S. Patent No. 5,463,693 to Birli. The Office Action indicates that Applicants have "failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application" as required under 37 C.F.R. § 1.607(a)(5).

Applicants apply the elements of the claims to the present application in attached Appendix B. It should be noted, however, that Applicants expressly reserve the right to supplement or amend the guidance provided in Appendix B as necessary in the future.

Furthermore, with respect to the specific assertions made regarding the claims, Applicants have the following comments.

Applicants respectfully submit that the term "spacer" is supported by the application as filed as well as the original application that provides the present application with its effective filing date of October 1, 1993 (as discussed above in connection with the rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph).

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With respect to claims 4 and 13, Applicants note that "a clip for attaching said amplifier/loudspeaker assembly" as recited in claims 4 and 13 of Birli et al. is encompassed by the "means for attaching said amplifier/loudspeaker assembly" as recited in claims 4 and 13 of the present application.

With respect to claims 7 and 16, Applicants note that "thermoplastic material" as recited in claim 7 and 16 of Birli et al. is encompassed by "plastic material" as recited in claims 7 and 16 of the present application.

With respect to claims 8 and 17, Applicants note that the recitation "wherein said spacer is comprised of two half members sonically welded together" found in claims 8 and 17 of Birli et al. is encompassed by the recitation of "said spacer is comprised of a first member for connecting to the face mask and a second member for connecting to the air filter" in claims 8 and 17 of the present application.

With respect to claims 9 and 18, Applicants respectfully submit that the recited "strain relief means" is supported by the application as filed and the original application that provides the present application with its effective filing date of October 1, 1993. Further discussion regarding support for this recitation can be found in the discussion regarding the rejection under 35 U.S.C. § 112, first paragraph above.

With respect to claim 12, please note that the language identified in the Office Action has been deleted from the claim.

With respect to claims 19 and 20, Applicants respectfully submit that the recited "clean air envelope" includes "an interior space" as recited in claims 19 and 20 of Birli et al.

As a result, Applicants respectfully submit that the claims pending in the present application do form a proper basis for a declaration of interference with Birli et al. as set forth in the Communication filed on February 4, 2002.



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Summary

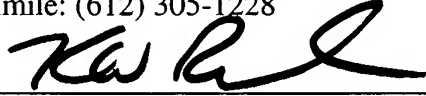
It is respectfully submitted that the pending claims 1-20 are in condition for allowance and notification to that effect is respectfully requested. It is further submitted that the pending claims support the declaration of an interference with U.S. Patent No. 5,463,693 to Birli et al. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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22 APRIL 2002

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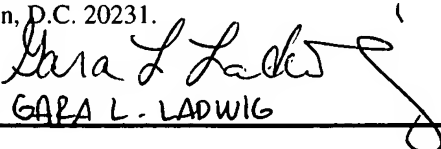
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